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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,950	07/21/2003	Jason Brown	C02-0109-000	4621

33190   7590   12/12/2006

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EXAMINER
TERMANINI, SAMIR

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>21 July 2003</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-20* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *21 July 2003* is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to the following communications: Application filed

on 7/21/2003.

2.   Claims 1-20 are pending. Claims 1, 11, and 19 are in independent form.

CLAIM REJECTIONS - 35 U.S.C. §101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine,
> manufacture, or composition of matter, or any new and useful improvement
> thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

4.   **Claims 11-18** are rejected under 35 U.S.C. §101 because the claimed

invention is directed to non-statutory subject matter, and further raises questions as to

whether the claims are directed to an abstract idea. More specifically, the claims lack the

necessary physical articles or objects to constitute a machine or a manufacture within the

meaning of 35 U.S.C. 101. They are clearly not a series of steps or acts, to be a process, nor

are they a combination of chemical compounds to be a composition of matter. The

"apparatus" of claims 11-18 appears to be a computer program claimed as computer listings

per se, i.e., the descriptions or expressions of the programs not limited to those that are

"computer-readable" and likewise does not define any structural and functional

interrelationship between the computer program and other claimed elements of a computer

which permit the computer program's functionality to be realized. Therefore, claims 11-18,

being directed toward computer listings *per se*, fail to fall within a statutory category.

5.   For the purposes of examination, claims 11-18 are being examined as if they were directed toward subject matter claimed as embodied on a computer-readable medium.

INFORMATION DISCLOSURE STATEMENT

6.   The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the Examiner on form PTO-892, they have not been considered.

CLAIM REJECTIONS - 35 U.S.C. §112

7.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8.   Claim 19 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention as claimed.

9.   More specifically, claim 19 recites "...a display device for presenting text to the apparatus..." (emphasis added). The word 'presenting' appears only twice within the

entire application - once within paragraph [0009] and once in claim 19. When it appears in

paragraph [0009], it is for presenting text to a user. Notwithstanding the permissible shift

in Applicant's terminology, from 'displaying' to 'presenting', the application uses, *inter alia*,

"display" and "displayed" as terminology to elucidate (and claim) features related to

displaying text to users through the display of a communications device. Displaying text on

a display of a communications device is well known in the art and the Applicant does not

have to provide a disclosure that describes those elements. However, a display device for

presenting text to itself, is not; And Applicant must provide a disclosure that describes

those elements in the specification in such a way as to enable one skilled in the art to which

it pertains, or with which it is most nearly connected, to make and/or use the display device

for presenting text to itself.

10.   In the interest of advancing prosecution, claim 19 is being examined as if

claim 19 was amended to recite "...a display device for presenting text to a user of the

apparatus..." as articulated in para. [0009] – the paragraph reciting language most nearly

connected to the embodiment being claimed in claim 19.

CLAIM REJECTIONS - 35 U.S.C. §102

11.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102

that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or
a foreign country or in public use or on sale in this country, more than one
year prior to the date of application for patent in the United States.
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12.   Claims 1-20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated

by *Digital cellular telecommunications system (Phase 2+) (GSM); Universal Mobile*

Telecommunications System (UMTS); USIM Application Toolkit (USAT); (3GPP TS 31.111

version 4.4.0 Release 4), European Telecommunications Standards Institute 2001

(hereinafter "*ETSUSIM*").

As to independent **claim 1**, *ETSUSIM* teaches a method, comprising the steps of:

controlling a display of a communications device ("DISPLAY TEXT: which displays text or

an icon on screen." pp. 21, §6.1) using a Subscriber Identity Module application

("specifically for "USIM Application Toolkit" pp. 10, section 1; Also, USIM means "Universal

Subscriber Identity Module" pp. 13, 2nd to last definition); and specifying a duration

("duration of the display" pp. 24, §6.4.1) in the Subscriber Identity Module application for

which text is displayed ("A duration object that represents the variable display timeout may

be included by the UICC." pp. 24, §6.4.1; See also "Proactive UICC gives a mechanism

whereby the UICC can initiate USIM initialization request and notification..." pp. 14; see

also "proactive UICC session: sequence of related USAT commands and responses" pp. 12,

6th definition).

As to dependent **claims 2**, *ETSUSIM* further teaches the step of specifying the

duration for which the text is displayed comprises an attribute in the Subscriber Identity

Module application ("the SIM/ME interface is the bearer level." pp. 63, before §6.7), the

attribute specifying the duration for which the text is displayed ("duration for execution of

the command" pp. 52, §6.6.1; see also figure 6.6.1, an annotated version is reproduced

immediately below).

6.6.1   DISPLAY TEXT

Attribute specifying duration

Description	Clause	M/O/C	Min	Length
Proactive UICC command Tag	9.2	M	Y	1
Length (A+B+C+D+E+F)	-	M	Y	1 or 2
Command details	8.6	M	Y	A
Device identities	8.7	M	Y	B
Text string	8.15	M	Y	C
Icon identifier	8.31	O	N	D
Immediate response	8.43	O	N	E
Duration	8.8	O	N	F

As to dependent **claim 3**, *ETSUSIM* further teaches the data object for a DISPLAY TEXT (e.g. "interface data object" pp. 63, before §6.7).

As to dependent **claim 4**, *ETSUSIM* further teaches that the "duration" data object is a parameter in the DISPLAY TEXT command ("A duration object that represents the variable display timeout" pp. 24, §6.4.1).

As to dependent **claim 5**, *ETSUSIM* further teaches the step of specifying the duration comprises specifying a time for which the text is displayed before clearing the text ("variable display timeout...informs the ME about the required duration of the display" pp. 24, bottom of page).

As to dependent **claims 6 and 7**, *ETSUSIM* further teaches that the duration comprises specifying the duration for which the text is displayed before either: executing a command to clear the text or until a user clears the text ("indicates that the ME shall wait for the user to clear message" pp. 24, bottom of page).

As to dependent **claim 8**, *ETSUSIM* further teaches displaying the text until an external event is detected (e.g. "when a higher priority event occurs, e.g. an incoming mobile terminated call." pp. 25, §6.4.1).

As to dependent claim 9, *ETSUSIM* further teaches displaying the text until an internal event is detected (e.g. "the expiration of the variable display timeout, if so indicated by the duration object" pp. 25, §6.4.1).

As to dependent claim 10, *ETSUSIM* further teaches the method according to claim 1, further comprising utilizing a Subscriber Identity Module application toolkit to create the Subscriber Identity Module application ("The present document defines the interface between the Universal ICC (UICC) and the Mobile Equipment (ME), and mandatory ME procedures, specifically for "USIM Application Toolkit" pp. 10, §1; see also "USAT USIM Application Toolkit" pp. 13, before § 3.3).

As to independent claim 11, *ETSUSIM* teaches an apparatus, comprising: a Subscriber Identity Module for use in a communications device ("Mobile Equipment" pp. 139, Annex A), the Subscriber Identity Module storing a Subscriber Identity Module application in memory ("image of USIM EFs in the ME's memory" pp. 40, §6.4.22); wherein the Subscriber Identity Module application specifies a duration for which text is displayed on the communications device ("duration of the display" pp. 24, §6.4.1) .

As to dependent claim 12, *ETSUSIM* further teaches the Subscriber Identity Module application utilizes attribute information (e.g. "the Attribute Information parameter" pp. 131, §8.67) to specify the duration for which the text is displayed ("duration for execution of the command" pp. 52, §6.6.1).

As to dependent claim 13, *ETSUSIM* further teaches that the Subscriber Identity Module application specifies a "duration" data object for a DISPLAY TEXT command (e.g. "interface data object" pp. 63, before §6.7).

As to dependent claim 14, *ETSUSIM* further teaches that the duration specifies a time for which the text is displayed before the text is cleared ("variable display timeout... informs the ME about the required duration of the display" pp. 24, bottom of page).

As to dependent claims 15 and 16, *ETSUSIM* further teaches an apparatus according to claim 11 wherein the duration specifies a time for which the text is displayed before either: executing a command to clear the text or until a user clears the text ("indicates that the ME shall wait for the user to clear message" pp. 24, bottom of page).

As to dependent claims 17 and 18 , *ETSUSIM* further teaches Subscriber Identity Module is embodied in a card and plug that interfaces with the communications device ("card defined in GSM 02.17" pp. 146, Annex G: Multiple Card Operation).

As to independent claim 19, *ETSUSIM* teaches an apparatus, comprising: circuitry for at least one of receiving and transmitting signals ("received/transmitted" pp. 62, 3rd para.); a display device for presenting text to a user of the apparatus ("screen", pp. 21, §6.1); a microprocessor for controlling the circuitry and the display device ("execute" and "processing", pp. 12, §3.1); and a Subscriber Identity Module executing a Subscriber Identity Module application stored in memory, the Subscriber Identity Module application ("specifically for "USIM Application Toolkit" pp. 10, section 1; Also, USIM means "Universal Subscriber Identity Module" pp. 13, 2nd to last definition) comprising an attribute specifying a time for which text is displayed on the display device (See "Duration," figure 6.6.1 on pp. 52).

As to dependent claim 20, *ETSUSIM* further teaches that the attribute comprises a "duration" data object in a DISPLAY TEXT command, the "duration" data object specifying

the time for which the text is displayed on the display device ("A duration object that

represents the variable display timeout" pp. 24, §6.4.1).

CONCLUSION

13.   Although not relied upon, the following prior art is made of record because it
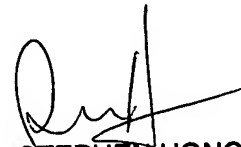
considered pertinent to Applicant's disclosure:

[1]   *Choquet et al.* (US 6178324 B1) for teaching a method of adapting an
operation of a subscriber identity module to one or more interfaces of a
mobile radio communication terminal and to provide a subscriber identity
module that enables the method to be implemented.

[2]   *Hubbe et al.* (US 6667748 B1) for teaching a method of displaying image
sequences on mobile radio communications equipment co-operating with a
subscriber identity module.

[3]   *Kahan et al.* (US 20020024536 A1) for teaching data items formatted for
display according to a mobile terminal subscriber's provisioning profile that
are transmitted to the mobile terminal subscriber's terminal for viewing by
the subscriber.

[4]   *Background information: Why do we need Variable Timeout* (CR 31.111: T3-
010136, T3-010137), Celltick Technologies, 3GPP T3 #18, Sophia Antipolis,
France, 1-2 March, 2001.

14.   Any inquiry concerning this communication or earlier communications from

the Examiner should be directed to Samir Termanini whose telephone number is (571) 270-

1047. The Examiner can normally be reached from 9 A.M. to 4 P.M., Monday through
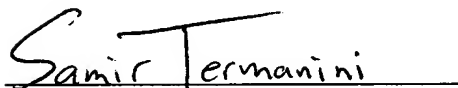
Friday (excluding alternating Fridays).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's

supervisor, Stephen S. Hong can be reached on (571) 272-4124. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, *see* http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

STEPHEN HONG
SUPERVISORY PATENT EXAMINER

Samir Termanini
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Art Unit 2178